

DETAILED ACTION

1. Claims 1-24 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 12/14/2007.

A review of the claims and updated search necessitated the rejections below.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 25 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Siegel Jr. et al. (2002/0032629), further in view of Socially Responsible Investment: Your Questions Answered - An Information Guide for

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Superannuation Trustees and Fund Managers (Monash Sustainability Enterprises and KPMG, July 2001).

As per claim 25;

Socially Responsible Investment discloses:

A method for creating a corporate responsibility fund set of securities, the method comprising (Socially Responsible Investment, page 3: How is SRI applied in practice?):

Socially Responsible Investment does not disclose:

identifying a first set of companies, each of the companies associated with a security:

assigning a first philanthropy score to each company in the first set;

assigning a second philanthropy score to each company in the first set;

selecting a at least two companies based on the first and second philanthropy scores so as to create a second set of companies for investment; and

selecting at least one security from each of the companies in the second set for inclusion into the corporate responsibility fund set of securities.

However, Siegel Jr. et al. discloses:

Providing a pool of equities with one or more parameters, ranking for each parameter, weighting each parameter, scoring based on weighting and parameter ranking, sorting according to score (paragraph 0020) and creating a reduced number of equities (paragraph 0023).

Therefore it would have been obvious to one of ordinary skill in the art, at the time of this invention, to combine the methods of Socially Responsible Investing and Siegel Jr. et al. One of ordinary skill in the art would have been motivated to do so in order to combine investors' financial objectives with their commitment to social justice, economic development, peace and a healthy environment.

As per claim 26;

Socially Responsible Investing does not disclose:

The method as recited in claim 25 wherein the selecting includes selecting at least two securities when the first philanthropy score exceeds a first threshold score or the second philanthropy score exceeds a second threshold score.

However, Siegel Jr. et al. discloses:

Selecting a number of equities with the highest or lowest scores (par. 0023) and choosing to allow or disallow equities that do not lie within specified parameter ranges (par. 0024).

Therefore it would have been obvious to one of ordinary skill in the art, at the time of this invention, to combine the methods of Socially Responsible Investing and Siegel Jr. et al. One of ordinary skill in the art would have been motivated to do so in order to establish a base screening level or level of acceptability.

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2. Claims 27-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Siegel Jr. et al. (2002/0032629), in view of Socially Responsible Investment: Your Questions Answered - An Information Guide for Superannuation Trustees and Fund Managers (Monash Sustainability Enterprises and KPMG, July 2001), and Social Rating Criteria, (Kinder, Lydenberg, Domini & Co., 2000 (KLD)).

As per claim 27;

Socially Responsible Investing does not disclose:

The method as recited in claim 25 wherein the first philanthropy score is a function of a philanthropy contribution amount contributed by the respective company over a predetermined time period.

However, KLD discloses;

An evaluation of corporate social performance using strength and concern ratings (introduction) which include generous giving defined as 1.5% of three year net earnings before taxes (pg. 4).

Therefore it would have been obvious to one of ordinary skill in the art, at the time of this invention, to combine the methods of Socially Responsible Investing, Siegel Jr. et al. and KLD. One of ordinary skill in the art would have been motivated to do so in order to establish a comprehensive evaluation of corporate social performance.

As per claim 28;

Socially Responsible Investing does not disclose:

The method as recited in claim 27 wherein the second philanthropy score is a function of a ratio of the first philanthropy score to a performance indicator the respective company during the predetermined time period.

However, Siegel Jr. et al. discloses:

Assigning a parameter ranking, selecting a weighting function and assigning a score based on weighting function and parameter ranking (par. 0020).

Therefore it would have been obvious to one of ordinary skill in the art, at the time of this invention, to combine the methods of Socially Responsible Investing, Siegel Jr. et al. and KLD. One of ordinary skill in the art would have been motivated to do so in order to select investments according to user preferences.

As per claim 29;

Socially Responsible Investing does not disclose:

The method as recited in claim 28 wherein the performance indicator is a pre-tax net earnings.

However, KLD discloses:

Corporate social performance evaluations using strength indicators such as generous giving based on pre-tax net earnings (pg. 4).

Also Siegel Jr. et al. discloses:

Weighting equity parameters of interest (par. 0018).

The examiner asserts that the weighting function could thus be based on the value placed on the generous giving performance. The examiner also asserts that the weighting function is necessarily a ratio which is used modify and score the parameter to the user's preferences.

Therefore it would have been obvious to one of ordinary skill in the art, at the time of this invention, to combine the methods of Socially Responsible Investing, Siegel, Jr. et al and KLD. One of ordinary skill in the art would have been motivated to do so in order to select investments according to user preferences.

3. Claims 30-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Siegel Jr. et al. (2002/0032629), in view of Socially Responsible Investment: Your Questions Answered - An Information Guide for Superannuation Trustees and Fund Managers (Monash Sustainability Enterprises and KPMG, July 2001), Social Rating Criteria, (Kinder, Lydenberg, Domini & Co., 2000 (KLD)) and Official Notice.

As per claims 30-32;

Socially Responsible Investing does not disclose:

A computer readable medium having stored thereon computer executable process steps operative to perform a method for selecting a set of securities for investment, the process steps comprising:

receiving a list of a first set of companies;

receiving a first philanthropy score corresponding to each of the companies in the first set;

receiving a second philanthropy score corresponding to each of the companies in the first set;

comparing the first philanthropy score for each of the companies in the first set to a first threshold score;

comparing the second philanthropy score for each of the companies in the first set to a second threshold score; and

selecting a company for inclusion in the set of companies for investment when either the first philanthropy score for the company exceeds the first threshold score or the second philanthropy score for the company exceeds the second threshold score.

The computer readable medium as recited in claim 30 wherein the first philanthropy score is a philanthropic contribution amount contributed by the respective company during a predetermined time period.

The computer readable medium as recited in claim 31 wherein the second philanthropy score is a ratio of the first philanthropy score to a performance indicator of the respective company during the predetermined time period.

However, the examiner takes Official Notice that it is old and well known in the art to use computer readable mediums for storing executable code to automatically perform various processes.

Therefore it would have been obvious to one of ordinary skill in the art, at the time of this invention, to combine the methods of Socially Responsible

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Investing, Siegel Jr. et al., KLD and Official Notice. One of ordinary skill in the art would have been motivated to do so in order to automate the methods previously disclosed.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William E. Rankins whose telephone number is 571-270-3465. The examiner can normally be reached on M-F 7:30 AM - 5:00 PM, off alt Fridays beg 6/15/07.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Dixon can be reached on 571-272-6803. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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